

The restriction requirement is respectfully traversed. Applicants do not contest the Examiner's assertion that the various sets of claims and the species are patentably distinct from each other. Rather, Applicants refer the Examiner to M.P.E.P. § 803, which sets forth the criteria and guidelines for Examiners to follow in making proper requirements for restriction. The M.P.E.P. instructs the Examiner as follows:

If the search and examination of an entire application can be made without serious burden, the Office must examine it on the merits, even though it includes claims to distinct or independent inventions.

M.P.E.P. § 803.

The Examiner's justification is without merit because a proper search of a method for providing transfer-resistant properties to a cosmetic composition comprising including in the composition a solid water-in-oil emulsion would necessarily encompass the composition of claim 107, which is directed to a transfer-resistant cosmetic composition. Newly added claim 107, like claim 108, was not originally presented, yet claim 107 was examined.

Thus, Applicants respectfully submit that the restriction requirement is in error and request that the requirement be withdrawn.

III. Rejections Under 35 USC § 112

Claims 87-89, 94, and 107 are rejected under 35 U.S.C. § 112, second paragraph as allegedly being indefinite for the reasons set forth on pp. 2-3 of the present Office Action. Applicants respectfully traverse this rejection for the following reasons.

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

The Examiner rejects claims 87-89 because "it is unclear if the claims require a volatile isoparaffin in addition to or in place of the silicone oil of the independent claim." Office Action, page 2. In accordance with the Examiner's proposed modification, claim 87 has been amended to recite "wherein the at least one oil in the fatty phase further comprises a volatile isoparaffin."

The Examiner rejects claim 94 for broadening the independent claim. Claim 94 has been cancelled, and thus this rejection is moot.

The Examiner rejects claim 107 because "it is unclear what amount of the emulsion is effective to provide transfer resistance to a cosmetic composition." Office Action at page 3.

In order to meet the requirements of 35 U.S.C. § 112, second paragraph, the claims must set forth the subject matter that applicants regard as their invention, and the claims must particularly point out and distinctly define the metes and bounds of the subject matter that will be protected by the patent grant. See M.P.E.P. § 2171. Moreover, the use of relative terminology in a claim does not automatically render that claim indefinite, as the standard for indefiniteness is whether those of ordinary skill in the art would be reasonably apprised of the scope of the invention. M.P.E.P. § 2173.05(b). In the present case, the phrase "an amount effective to provide transfer-resistant properties to the composition" clearly delineates the metes and bounds of the claimed invention by reciting in functional form the requisite amounts of the active ingredients.

According to the present specification, the compositions of the prior art exhibit the disadvantage of transferring, i.e., the prior art compositions are "at least partly

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

deposited, while leaving a trace" on items that contact the compositions. Page 2, lines 4-11. As a result, the film's persistence on the skin is mediocre. *Id.* Surprisingly, the inventors have discovered that the use of the composition as claimed in claim 107 exhibits the advantage of not transferring. Page 3, lines 7-14. The specification provides numerous exemplary ingredients that can be used by one of ordinary skill in the art.

Additionally, claim 107 guides one of ordinary skill in the art to use at least one wax in the fatty phase capable of conferring a penetration force on the emulsion of greater than or equal to 50 grams. The specification provides exemplary waxes, combinations of such waxes that can be used, and methods for measuring the penetration force.

Finally, the Examiner has provided no reasoning why one of ordinary skill in the art would not be able to understand the metes and bounds of "amount effective to provide transfer-resistant properties to the composition," except via a *per se* argument, which is not permitted under M.P.E.P § 2173.05(b). Thus, this term does not need to be quantified for one of ordinary skill in the art to be reasonably apprised of the scope of the claims.

For at least the above-stated reasons, it is believed that the pending claims satisfy 35 U.S.C. §112, second paragraph and all rejections should be withdrawn.

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

IV. Rejections under 35 USC § 103

A. Mellul et al. and Nicoll et al.

Claims 75-80, 82-86, 90-94 and 97-107 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Mellul et al. (EP 595 683, which corresponds to U.S. Patent No. 5,851,539¹) in view of Nicoll et al. (U.S. Patent No. 5,196,187) for the reasons set forth on pp. 4-5 (paragraph 13) and pp. 6-7 (paragraphs 18-20) of the Office Action. Applicants respectfully traverse this rejection for the reasons of record and for the following additional reasons.

Claim 75 is directed to a solid water-in-oil emulsion comprising an aqueous phase emulsified in a fatty phase comprising at least one oil and at least one wax, wherein the aqueous phase is emulsified using an alkyl dimethicone copolyol corresponding to the formula as indicated in the claim. The at least one oil in the fatty phase comprises a silicone oil, and the at least one wax is chosen from polyethylene wax, hydrogenated jojoba oil, and ozokerite. Claim 104 is directed to a process of making up the skin and/or the scalp, comprising applying to the skin or scalp the solid emulsion as described for claim 75. Claim 107 is directed to a transfer-resistant composition comprising a solid water-in-oil emulsion comprising an aqueous phase emulsified in a fatty phase comprising at least one oil and at least one wax, wherein the aqueous phase is emulsified using an alkyl dimethicone copolyol corresponding to the formula as indicated in the claim. In all the claims, at least one wax in the fatty phase is

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

¹ The cites to Mellul are given with reference to U.S. Patent No. 5,851,539.

capable of conferring a penetration force on the emulsion of greater than or equal to 50 grams.

To establish a prima facie case of obviousness, *inter alia*, there must be a suggestion or motivation in the references themselves or in the art to modify the reference or combine reference teachings. See M.P.E.P. § 2143. Here, Mellul and Nicoll, alone or in combination, fail to teach or suggest the use of at least one wax capable of conferring a penetration force on the emulsion of greater than or equal to 50 grams. Additionally, the references fail to teach or suggest the selection of the specifically recited ingredients of the present claims, *i.e.*, at least one oil comprising a silicone oil and at least one wax chosen from polyethylene wax, hydrogenated jojoba oil, and ozokerite.

Mellul is directed to water-in-silicone oil emulsions with a continuous phase having at least one fluorohydrocarbon. Mellul teaches that hydrocarbon oils and waxes can be used "as additive." Col. 6, lines 35-36. In other words, the basic components deemed significant by Mellul do not include a wax; instead, these oils and waxes are simply optional ingredients.

Moreover, Mellul discloses a near infinite number of possible compositions, yet fails to provide guidance to select the specifically claimed combination of: (1) the at least one wax capable of conferring a penetration force on the emulsion of greater than or equal to 50 grams, chosen from polyethylene wax, hydrogenated jojoba oil, and ozokerite; (2) the alkyl dimethicone copolyol of the indicated formula; (3) a solid cosmetic water-in-oil emulsion; and (4) the at least one oil comprising a silicone oil.

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

Specifically, Mellul provides no guidance to specifically select the waxes and oils of the rejected claims from a long list of potential oils and waxes. See col. 6-7. There is no requirement that at least one oil and at least one wax as defined by Applicants be selected as part of the cosmetic composition. Further, there is no reason why one of ordinary skill in the art would have chosen silicone oil as the required oil and at least one of hydrogenated jojoba oil, ozokerite, and polyethylene wax as the required wax(es). In addition, Mellul does not even remotely suggest that when the at least one wax is added it must be a wax capable of conferring a penetration force on the emulsion of greater than or equal to 50 grams. The penetration force indicates the structural solidity of the compound. For instance, Example 3 of the present specification compares two inventive compositions with a non-inventive composition containing carnauba wax. See pp. 20-21. The comparison illustrates that the non-inventive composition containing carnauba wax, a wax not capable of conferring the claimed penetration force, did not produce a sufficiently solid composition. See pg. 21.

Finally, Mellul states, at col. 10, lines 16-21, that the emulsion can vary from the "very fluid to the solid state," and thus provides no specific teaching to select a solid cosmetic water-in-oil-emulsion, particularly in combination with the other components described above.

It can be readily seen that one of ordinary skill in the art would have had to use hindsight to pick and choose the claimed combination of components from a near infinite number of possibilities. Mellul does not specifically teach this combination.

Nicoll does not remedy the deficiencies of Mellul, as discussed of record. Nicoll, drawn to water-in-silicone oil emulsions, also fails to teach or suggest waxes that can

confer the presently claimed penetration force. Moreover, Nicoll directly teaches away from a solid composition, as Nicoll teaches that the emulsion is to be formulated as a lotion, a fluid cream, or a cream. See col. 10, lines 32-45; see also Examples 1-4 describing lotions and creams.

Further, in response to Applicants' argument that the Examiner based the rejection on hindsight, the Examiner tries to justify her hindsight reasoning by relying on *In re McLaughlin*, 443 F.2d 1392 (C.C.P.A. 1971). The court in *McLaughlin*, however, resolved the obviousness issue by analyzing secondary considerations. Thus, the *McLaughlin* holding did not turn on the *prima facie* case of obviousness, and thus, the court's statements regarding hindsight can be classified as dicta. At any rate, the Examiner cannot ignore the overwhelming case law requiring a clear suggestion or motivation to arrive at the invention without the benefit of hindsight. Merely identifying each of the claimed elements in the prior art is not sufficient to establish a *prima facie* case of obviousness. The suggestion or motivation to combine references must be "clear and particular." See *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999).

Regarding claim 107, the Examiner states that "preamble limitations [of transfer resistant] are not given patentable weight over the prior art composition." Office Action at page 4. This statement, however, amounts to a *per se* standard, which is not the proper standard for evaluating preamble limitations. Whether a preamble limitation is considered is based on whether the preamble "gives life, meaning, and vitality" to the claims. M.P.E.P. § 2111.02, quoting *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305 (Fed. Cir. 1999). As discussed in response to the § 112 rejection,

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

"transfer-resistant" describes a property of the composition view of the specification and the knowledge of those of ordinary skill in the art.

The Examiner also states that "absent evidence of unexpected results over the prior art, the limitation regarding the capability of a wax to confer a penetration force on the emulsion of greater than 50 grams is not given patentable weight." Office Action at pages 6-7. Applicants disagree. As set forth above, and as further discussed below, the Examiner has not established a *prima facie* case of obviousness here. None of the combinations of references applied by the Examiner to the pending claims meet the high standard articulated by the Federal Circuit in *Dembiczak, supra*, and other recent cases, *i.e.*, that the evidence of a motivation to combine must be "clear and particular."

If a *prima facie* case has not been established, Applicants do not have the burden of showing any unexpected results. According to the M.P.E.P., if the Examiner does not establish a *prima facie* case, the applicant need not submit any evidence of nonobviousness. Indeed, "[t]he lack of objective evidence of nonobviousness does not weigh in favor of obviousness." See M.P.E.P. § 716.01(a). Only if the Examiner demonstrates a *prima facie* case of obviousness does the burden shift to the applicant to come forward with evidence persuasive of the invention's nonobviousness. See *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984).

Nevertheless, even if a *prima facie* case of obviousness were established (which Applicants do not concede), the Examiner is still required to give weight to all elements of the claims at issue. The citation of *In re Spada*, 15 U.S.P.Q. 1655 (Fed. Cir. 1990) for the proposition that discovery of a new property or use of a previously known composition cannot impart patentability to claims to a known composition (page 4 of

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

Office Action) is not relevant to the point at hand. By including in their claimed invention only waxes with the recited property, Applicants are limiting the scope of the waxes that are useful in their invention. As shown in the present specification, waxes lacking this property do not give satisfactory results. Accordingly, the limitation must be given patentable weight. "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385 (C.C.P.A.1970); see also M.P.E.P. § 2143.03.

Thus, in light of the above, Applicants believe that both "transfer resistant" and "capable of conferring a penetration force of greater than or equal to 50 grams" should be accorded patentable weight. Further, since neither Mellul nor Nicoll, alone or in combination, teaches at least one wax having the claimed penetration force, the Examiner has failed to establish a *prima facie* case of obviousness. Accordingly, Applicants respectfully request withdrawal of this rejection.

B. Mellul et al. and Nojima

Claims 75-80, 82-84, 90-94, and 96-107 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Mellul et al. in view of Nojima (U.S. Patent No. 5,650,139) for the reasons set forth on p. 5 of the present Office action and on pp. 6-7 of paper no. 7. Applicants respectfully traverse this rejection for the reasons of record and for the following additional reasons.

First, the Examiner has failed to address the substance of Applicants' arguments made in response to this rejection, namely that Mellul is directed to water-in-oil emulsions and provides numerous examples where water is the predominant component of the composition, whereas Nojima relates to oil-based cosmetic

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

compositions and provides numerous examples of compositions free of added water.

"Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection take note of the applicant's argument and answer the substance of it."

M.P.E.P. § 707.07(f).

Thus, Applicants question how one of ordinary skill in the art would be motivated to combine the water-in-oil emulsions of Mellul with the distinctly different oil-based compositions of Nojima. Nojima states that the oil-based cosmetic compositions are preferably "substantially free from water." Col. 3, lines 40-42. All of the numerous examples are free of added water, and thus Nojima fails to describe a water-in-oil emulsion, as required by the present claims. When read as a whole, therefore, the teachings of Nojima teach away from the water-in-oil compositions of Mellul. Thus, because motivation to combine the references is missing, the Examiner has failed to establish a *prima facie* case of obviousness.

Second, Mellul and Nojima, alone or in combination, fail to teach or suggest the use of at least one wax capable of conferring a penetration force on the emulsion of greater than or equal to 50 grams. As discussed *supra*, Mellul neither teaches nor suggests the properties of the claimed at least one wax and Nojima does not remedy the shortcomings of Mellul. Specifically, although Nojima lists "oil ingredients" (including some compounds defined by Applicants as waxes) at col. 3, lines 44-60, Nojima does not teach or suggest at least one wax capable of conferring a certain penetration force as claimed, much less a solid water-in-oil emulsion comprising an aqueous phase and a fatty phase containing such wax(es).

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

Third, Nojima provides a large number of possibilities of polyoxyalkylene modified organopolysiloxanes in col. 2, yet does not provide guidance to specifically select the presently claimed alkyl dimethicone copolyol.

Finally, Mellul and Nojima, alone or in combination, fail to provide guidance to specifically choose the claimed combination of components, namely, the solid cosmetic water-in-oil emulsion, the at least one wax, the at least one oil comprising a silicone oil, and the alkyl dimethicone copolyol of the indicated formula.

Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness and Applicants respectfully request withdrawal of this rejection.

C. Mellul et al. and Nara et al.

Claims 75-80, 82-84, 87-94, and 97-107 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Mellul et al. in view of Nara et al. (U.S. Patent No. 4,536,405) for the reasons set forth on page 5 of the present Office Action and on pp. 7-8 of paper no. 7. Applicants respectfully traverse this rejection for the reasons of record and the following additional reasons.

Again, the Examiner has failed to answer the substance of the Applicant's arguments to support the impropriety of combining Mellul and Nara, as required. M.P.E.P. § 707.07(f). Mellul teaches compositions comprising an aqueous phase emulsified with a silicone surfactant in a continuous phase of a fluorohydrocarbon, whereas Nara, in contrast, teaches makeup compositions comprising ethyl hydroxyethyl cellulose and an aromatic hydrocarbon resin having a softening point of at least about 120°C. The water-in-oil emulsions of Mellul are distinctly different from the ethyl hydroxyethyl cellulose compositions of Nara. One of ordinary skill in the art would not

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

have been motivated to combine the teachings of Mellul and Nara without the benefit of hindsight. As no such suggestion or motivation to combine exists, the Examiner has not established a prima facie case of obviousness.

Additionally, Mellul or Nara, alone or in combination, fail to teach or suggest the use of at least one wax capable of conferring a penetration force on the emulsion of greater than or equal to 50 grams. As discussed above, Mellul neither teaches nor suggests the combination of at least one oil comprising a silicone oil, and at least one wax chosen from polyethylene wax, hydrogenated jojoba oil, and ozokerite, where the wax presents the claimed penetration forces. Nara does not remedy the shortcomings of Mellul as a primary reference. Specifically, Nara does not teach either the presently claimed alkyl dimethicone copolyol or the desirability of using at least one wax capable of conferring a penetration force on the emulsion of greater than or equal to 50 grams. Moreover, although Nara discloses a list of liquid oil ingredients at col. 4, lines 13-18, Nara in no way teaches or suggests selecting at least one oil comprising a silicone oil from this list.

Finally, Mellul and Nara, alone or in combination, fail to provide guidance to specifically choose the claimed combination of components, namely, the solid cosmetic water-in-oil emulsion, the at least one wax, the at least one oil comprising a silicone oil, and the alkyl dimethicone copolyol of the indicated formula.

The requisite suggestion or motivation for the combination of the references exists only in hindsight. As a result, the Examiner has failed to establish a prima facie case of obviousness.

Accordingly, Applicant respectfully requests withdrawal of this rejection.

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

V. Conclusion

In view of the foregoing, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this amendment and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: August 7, 2002

By: 
Thalia V. Warnement
Reg. No. 39,064

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

APPENDIX : MARKED UP CLAIMS

Version with markings shown in compliance with 37 C.F.R. § 1.121:

87. (Amended) The emulsion according to claim 75, wherein the at least one oil in the fatty phase **further** comprises a volatile isoparaffin.

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com